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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,856	04/21/1999	TODD R. COLLART	IACTP005	7668

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DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 MAIN STREET, SUITE 200
IRVINE, CA 92614

EXAMINER

RODRIGUEZ, PAUL L

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 09/08/2003

40

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/295,856

Applicant(s)

COLLART, TODD R.

Examiner

Paul L Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/23/03, 8/15/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 47, 50-59 and 62-81 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 79-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47, 50-59 and 62-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21, 47, 50-59 and 62-81 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 37.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The amendment filed 8/15/03 and IDS filed 6/23/03 have been received and considered. Claims 47, 50-59 and 62-78 are presented for examination. Claims 21, 79-81 have been withdrawn from consideration.

Election/Restrictions

2. Claims 21 and 78-81 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 38.

3. Applicant's election without traverse of Group II in Paper No. 38 is acknowledged.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 47, 52, 59, and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Brindze et al (U.S. Pat 5,822,291). The claimed invention reads on Brindze et al as follows.

Brindze et al discloses (claim 47) a method for providing selective access to data on an electronic storage medium (col. 1 lines 10-13) comprising providing said data for storage on said

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electronic storage medium (col. 1 lines 61-63, col. 1 line 65 – col. 2 line 1, col. 4 lines 19-21), requesting that an identifier be incorporated on said electronic storage medium in conjunction with said data (col. 1 lines 53-65, col. 3 lines 30-38) and providing pertinent user information (col. 4 lines 45-61, col. 5 line 57 – col. 6 line 4, col. 7 lines 11-20, col. 8 lines 5-16), wherein said identifier identifies a specific instance of said electronic storage medium (col. 1 lines 58-65, col. 3 lines 58-62, examiner relies upon the definition of the word “instance”, defined as any individual, person, act or thing that may be offered to illustrate or explain, a “specific instance” is considered something that specifically defines, examiner considers a “unique serial identifier” as meeting this limitation) wherein said identifier is read when said electronic storage medium is inserted into a device (col. 7 lines 45-52), and said identifier as well as said pertinent user information are verified at a separate database (reference number 40, 46, 48, col. 5 line 63 – col. 6 line 4, col. 7 lines 11-20, col. 8 lines 5-16, col. 9 lines 65 – col. 10 line 10), wherein access to said data is precluded upon unsuccessful verification of said identifier and said pertinent user information (col. 7 lines 11-20, col. 10 lines 54-56, figures 3 and 4, shows that when not authorized access is not permitted), (claim 59) a method for providing selective access to data on an electronic storage medium (col. 1 lines 10-13), comprising receiving data from a source for storage in said electronic storage medium (col. 2 lines 8-14), incorporating an identifier on said electronic storage medium along with said data (col. 2 lines 15-19) and providing pertinent user information (col. 4 lines 45-61, col. 5 line 57 – col. 6 line 4, col. 7 lines 11-20, col. 8 lines 5-16), wherein said identifier identifies a specific instance of said electronic storage medium (col. 1 line 58-65, col. 3 lines 58-62) and is read upon insertion into a device (col. 7 lines 45-52), wherein said identifier and said pertinent user information are verified at a separate database (reference

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number 40, 46, 48, col. 5 line 63 – col. 6 line 4, col. 7 lines 11-20, col. 8 lines 5-16, col. 9 lines 63 – col. 10 line 9), and access to said data is precluded upon unsuccessful verification of said identifier and pertinent user information (col. 7 lines 11-20, col. 10 lines 54-56, figures 3 and 4, shows that when not authorized access is not permitted), and (claim 52, 64) wherein said data comprises multimedia data (col. 1 lines 10-19, col. 3 lines 20-22).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 50, 53-56, 58, 62, 65-67 and 69-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brindze et al (U.S. Pat 5,822,291) in view of EP 0802527 A1.

Brindze et al teaches most all of the instant invention as applied to claims 47, 52, 59 and 64 above. Brindze et al also teaches (claim 53, 65) a system for providing selective access to data on an electronic storage medium (reference number 10, col. 3 lines 20-38, figure 1), wherein said data and said identifier are stored on said electronic storage medium (col. 1 lines 53 – col. 2 line 19), (claim 71) receiving at a server computer (reference number 40) an identifier information (reference number 24) read from said electronic storage medium (col. 5 line 63 – col. 5 line 4, figure 4, col. 9 lines 63 – col. 10 line 10), receiving at a server computer pertinent user information (col. 5 line 57 – col. 6 line 4, col. 6 line 31-42), (claim 74) wherein the identifier information is updated and stored in a database (col. 10 lines 10-13, col. 10 lines 21-56,

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reference number 154 “update memory”), (claim 75) further comprising broadcasting one of the identifier information and the updated identifier information (transmitting is considered broadcasting, col. 7 lines 59-64, col. 11 lines 58-61), (claim 76) further comprising utilizing the identifier information to direct one of an e-commerce transaction and a “buy me” button to a retailer (col. 8 lines 39 – col. 9 line 8, examiner considers “buy me” as anticipated by the “enhanced multimedia format” and purchasing) and (claim 78) wherein the logic redirects a consumer to a storefront of a retailer (col. 9 lines 1-5).

Brindze et al fails to teach (claim 55, 67, 73) wherein said identifier is stored on a burst cut area (BCA) of said optical disc, (claims 50) wherein said steps of providing said data and requesting that an identifier be incorporated are directed toward an optical disc replicator, (claim 53) a receiver for incorporating an identifier on said electronic storage medium and a source for providing data to said receiver, (claim 56, 69) wherein said receiver is an optical disc replicator, (claim 56, 59) wherein said receiver is an optical disc replicator, (claim 63) wherein said steps of receiving data and incorporating an identifier are performed by an optical disc replicator, (claim 65) a source for providing data, a receiver for receiving said data from said source for storage in an electronic storage medium, said receiver producing said electronic storage medium having an identifier incorporated thereon in conjunction with said data (claim 71) verifying said identifier information and pertinent user information using a database (col. 4 lines 45-61, col. 6 line 60 – col. 7 line 43) transmitting an authorization key upon successful verification of said identifier information and (claim 77) further comprising providing a logic to control access to a web site, the logic being based on the identifier information stored on the BCA.

EP 0802527 A1 teaches (claim 55, 67, 73) wherein said identifier is stored on a burst cut area (BCA) of said optical disc (col. 1 lines 38-46), (claims 50) wherein said steps of providing said data and requesting that an identifier be incorporated are directed toward an optical disc replicator (figure 1, col. 3 lines 16-38, teaches the production of disc with unique ID in the BCA, figure 6 press factory, col. 5 lines 17-38), (claim 53) a receiver for incorporating an identifier on said electronic storage medium (col. 3 lines 16-38, figure 1, receives contents 777 and ID 921 for incorporation on disc), and a source for providing data to said receiver (reference number 777 figure 1), wherein said data and said identifier are stored on said electronic storage medium (abstract, figure 1, col. 3 lines 16-38, reference number 801 is a disk with BCA), (claim 56, 69) wherein said receiver is an optical disc replicator (figure 1, abstract), (claim 63) wherein said steps of receiving data and incorporating an identifier are performed by an optical disc replicator (figure 1, col. 3 lines 16-38, figure 6, press factory, col. 5 lines 17-38), (claim 65) a source for providing data (figure 1, reference number 777), a receiver for receiving said data from said source for storage in an electronic storage medium, said receiver producing said electronic storage medium having an identifier incorporated thereon in conjunction with said data (figure 1, col. 3 lines 16-38), (claim 71) transmitting an authorization key upon successful verification of said identifier information (abstract, soft cipher and cipher keys) and (claim 77) further comprising providing a logic to control access to a web site, the logic being based on the identifier information stored on the BCA (col. 8 line 45 – col. 9 line 11).

Brindze et al and EP 0802527 A1 are analogous art because they are both directed toward optical disks that contain identifying information and are both related to securing and accessing data on an optical disk.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the disk reproduction of EP 0802527 A1 in the optical disk access system of Brindze et al because EP 0802527 A1 teaches an improved method and system of identifying individual electronic storage mediums, an improved method of limiting access to an electronic storage medium (col. 1 lines 10-53), a simpler procedure for releasing a cipher of enciphered contents (col. 22 lines 39-43) and improvement of software security (col. 22 lines 44-48).

8. Claims 51 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brindze et al (U.S. Pat 5,822,291) in view of Gotoh et al (U.S. Pat 6,052,465).

Brindze et al teaches most all of the instant invention as applied to claims 47, 48, 52, 59, 60 and 64 above. Brindze et al fails to teach wherein said steps of providing said data and requesting that an identifier be incorporated on said electronic storage medium are performed by a content provider.

Gotoh et al teaches an optical disc reproduction that incorporates an ID on each optical disk (title, abstract) wherein said steps of providing said data and requesting that an identifier be incorporated on said electronic storage medium are performed by a content provider (figure 1, col. 9 line 66 – col. 10 line 22, software maker is considered the content provider).

Brindze et al and Gotoh et al are analogous art because they are both related to the protection of content on an optical disk.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the content provider of Gotoh et al in the optical disk access

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system of Brindze et al because Gotoh et al teaches a greatly improved pirated-disk and other illegal duplication prevention capability as compared to the prior art (col. 41 line 31 – col. 42 line 4).

9. Claims 57 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brindze et al (U.S. Pat 5,822,291) in view of EP 0802527 A1 as applied to claims 49, 50, 53-56, 58, 61, 62, 65-67 and 69-77 above, and further in view of Gotoh et al (U.S. Pat 6,052,465).

Brindze et al as modified by EP 0802527 A1 teaches an optical disk access system that reads data from an optical disk that incorporated identification information in a BCA as applied to 49, 50, 53-56, 58, 61, 62, 65-67 and 69-77 for the reasons above. Differing from the invention as recited in claims 57 and 68 in that their combined teaching lacks said steps of providing and requesting are performed by a content provider.

Gotoh et al teaches an optical disc reproduction that incorporates an ID on each optical disk (title, abstract) wherein said steps of providing and requesting are performed by a content provider (figure 1, col. 9 line 66 – col. 10 line 22, software maker is considered the content provider).

Brindze et al as modified by EP 0802527 A1 and Gotoh et al are analogous art because they are both related to the protection of content on an optical disk.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the content provider of Gotoh et al in the optical disk access system of Brindze et al as modified by EP 0802527 A1 because Gotoh et al teaches a greatly

improved pirated-disk and other illegal duplication prevention capability as compared to the prior art (col. 41 line 31 – col. 42 line 4).

Response to Arguments

10. Applicant's arguments filed 8/15/03 have been fully considered but they are not persuasive. Applicant argues that Brindze et al does not disclose providing pertinent user information. Examiner disagrees and can point to numerous examples of “user information”, user information that can be considered as “pertinent user information” are disclosed. For example see col. 4 lines 45-61, col. 5 line 57 – col. 6 line 4, col. 7 lines 11-20, col. 8 lines 5-16 which are just some locations in Brindze et al where the examiner considers the disclosure as defining pertinent user information. Brindze et al stores pertinent user information at the transaction unit 18, the transaction processing facility 40 and vendor interface 56 specifically in the key memory devices. One example of “pertinent user information” is the PIN established for each specific user, this example alone constitutes pertinent user information. As disclosed in Brindze et al, when the storage medium's identifier is verified, the users PIN and access to certain content is also verified by the TPF 40, this is considered by the examiner to disclose specifically the newly added claim limitation being argued by the applicant. From this example alone the examiner considered Brindze et al to clearly anticipates applicants claimed invention. Therefore, applicants arguments directed to the added claim limitation of pertinent user information are without merit and the rejections are maintained.

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Regarding the arguments directed toward the 103 based rejections, all arguments are directed toward the lack of the limitation “pertinent user information”, which as discussed above is clearly taught by Brindze et al and therefore the arguments are not persuasive.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reisman (U.S. Pat 6,594,692) – teaches a system and method for distributing content on an electronic storage medium, specifically a CD, having a user insert the CD into a personal computer for interaction with the medium, using a CD identifier along with pertinent user information, such as subscription information, to access content on the CD along with additional server provided information in response to a specific user profile.

Leeke et al (U.S. Pat 6,587,127) – teaches a content providing server for delivering content to a user based on the insertion of a smart card (electronic storage medium) into the users device, along with pertinent user information, so as to provide customized content to a user.

Sprague et al (U.S. Pat 5,247,575) – teaches the use of pertinent user information for the distribution of information to a user.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399. The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Paul L Rodriguez
Examiner
Art Unit 2125



PLR
8/27/03

LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100